UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
DAGNEW, SABA

ART UNIT	PAPER NUMBER
3688	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/759,553	PERRY, MORGAN
	Examiner	Art Unit
	SABA DAGNEW	3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _17 November 2008_.
2a)☒ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _6-8,10-17,19,20 and 23-28_ is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) _6-8,10-17, 19-20 and 23-28_ is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on _16 January 2004_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.
   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)
1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _17 November 2008_.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

U.S. Patent and Trademark Office
PTOL-326 (Rev. 08-06)   Office Action Summary   Part of Paper No./Mail Date 20090116

DETAILED ACTION

Status of Claims

This action is in reply to the amendment filed on 17 November 2008. Claims 6, 11, 16 and 19 have been amended. Claims 1-5, 9, 18 and 21-22 are cancelled. New claims 25-28 have been added. Claims 6-8, 10-17, 19, 20 and 23-28 are currently pending and have been examined.

Unless a term "advertising strategies" is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, but does not include ..." An example does not constitute a "clear definition" beyond the scope of the example.

Therefore, the Examiner interpreted "advertising strategies" as a method of displaying advertisements, for example, displaying via web site, as banner ad, on message board or using search term to display hyperlink.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 6-8, 10-15 and 23-28 are rejected under 35 U.S.C. 102(e) as being

anticipated by Radwin (7,007,074 B2).

With respect to claim 6, **Radwin** teaches a method of using one or more

processors to distribute Internet advertisement to users comprising:

for each of a plurality of advertising strategies *(Col. 12. lines 13-16, where "a*

visual advertising banner" reads on advertising strategy, Col. 15, lines 3-13, which

teaches using search term for advertisement display and Col. 16, lines 5-29, where

"message board web pages, audio advertisements , picture, music " reads on plurlity of

advertisements strategies and

with a processor, associating a plurality of advertisements with the advertising

strategy *(Col. 3, lines 19-34, where "advertisements and user profiler configured to*

communicate" reads on advertisements with an advertising strategy and Col. 4, lines

34-44, where "search terms determine which of the advertisements will be presented to

the user" reads on a plurality of advertisements with the advertising strategy);

with a processor (*Col. 4, lines 62-63, which teaches processors used to search*

back-end processors) associating a number of search terms with an advertising strategy

(*Col. 4, lines 34-39, Col. 5, lines 14-28, which teaches one or more search terms uses*

to find advertisements and Col. 6, lines 45-58); and

with a processor associating a time duration with the advertising strategy *(Col. 3,*

lines 38-48, which teach time-dependent advertisement associate with search term

(advertising strategy));

with a processor, assigning cookies to users of a search interface *(Fig. 8, 808*

and Col. 13, lines 19-22 and Col. 14, lines 8-14, which teaches setting cookie)

with a processor storing the collected search terms for each user in association

with each user's cookie*(Col. 13, lines 19-33 and Col. 14, liens 8-14, which teaches*

cookie contains an encrypted version of the ad type) ;

for each of a plurality of users *(Col. 7, lines 21-28, which teaches accessing*

records for each of the users),

based on the collected search terms (*Fig. 6, 602, where "receive search terms"*

reads on collected search terms), with a processor, selecting advertising strategy to

assign to the user by comparing a set of search terms associated with an advertising

strategy (*Fig. 6, 606 and 610*) to search terms collected for the user over the

immediately preceding period equal to the time duration associated with the selected

advertising strategy *(Fig. 6, 619 and 620, Col. 10, lines 16-25, which teaches selecting*

the most appropriate advertisement, which accompany the search result (match or

compared) and display advertisement as a banner (advertising strategy, **Col. 11, lines
49-67 and Col. 12 lines 1-5)** *and,*

in response to a user visiting a publisher web site, after the user is assigned to a

selected advertising strategy *(Col. 12, lines 17-22, which teaches user selects a web

page (advertising strategy) to view advertisement)*, enacting the selected advertising

strategy <u>to present an advertisement associated with the selected advertising strategy</u>

*(Fig. 6, 620 and Col. 12, lines 17-25, , which teaches user selects a web page

(advertising strategy) to view advertisement, and displaying on web page by clicking

hypertext links)*

With respect to claim 7, Radwin teaches all elements of claim 6. Furthermore,

Radwin teaches the method wherein collecting a unique identifier associated with each

user *(Fig. 3 where "user 0 ...user n" reads a unique indenter* **and Col. 15, lines 29-34).**

With respect to claim 8, Radwin teaches all elements of claim 6. Furthermore,

Radwin teaches the method wherein a collecting search term includes collecting

combinations of multiple search terms **(Col. 10, lines 5-15***)*.

With respect to claim 10, Radwin teaches all elements of claim 6. Furthermore,

Radwin teaches the method wherein assigning each user to an advertising strategy

occurs before the user visits the publisher web site *(Col. 5, lines 28-32, where teaches

a search query initiated to user before visiting web site)*.

With respect to claim 11, Radwin teaches all elements of claim 6. Furthermore,

Radwin teaches a method including <u>with a processor </u>providing a plurality of selected

advertisement *(Col. 4, lines15- 18)*, each associated with a selected advertising

strategy *(Col. 4, lines 21-23),* and wherein at least one the advertising strategies

comprised a default strategy in which none of the selected advertisements are served

(*Col. 14, lines 2- 7*, where *"run of the network advertisement" reads on default*

strategy).

As noted above, claims 12 and 13 are written as options, which do no limit

(MPEP § 2111.04), and where accordingly not given patentable weight.

Radwin does not explicitly teach in claims 14 serving no advertisement if the

search terms do no relate to one of a collection of selected ads. However, that is

inherent when there is no result to execute because the search terms do not produce a

result/ad, which reads on serving no ad

Claim 15 is taught inherently because enacting/serving/executing cannot be at

the same instant as searching.

With respect to claim 23, Radwin teaches all elements of clam 1, the method of

claim 6 wherein collecting search terms comprises collecting a history of inquiries the

user has submitted over a predetermined length of time (*Fig. 3 Col. 7, lines 28-30,*

where *"time stamp 77 identifies search term last used" reads submitted over*

predetermined length of time).

With respect to claim 24, Radwin teaches all elements of claim 1. Furthermore,

Radwin teaches collecting search terms comprises collecting a history of all queries the

user has submitted to the search facility *(Col. 4, lines 34-39, where "storing search*

terms" reads on submitting to the search facility and Col. 7 teaches, lines 21-40).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set
forth in section 102 of this title, if the differences between the subject matter sought to be patented and
the prior art are such that the subject matter as a whole would have been obvious at the time the
invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

Claims 16- 17 and 19-20 are rejected under 35 U.S.C. 103(a) as being obvious

over Radwin (7,007,074 B2) in view of Ponte (6,826,559 B1)

With respect to claim 16, a method of using one or more processors to distribute

Internet advertisements to users comprising:

with processor, collecting search terms employed by users of a search

facility*(Col. 11, lines 49-56 , where "search terms stored for later use" reads on*

collecting search terms);

with processor, collecting a unique identifier associated with each user *(Fig. 3,*

22 user profile contain user unique identifier (User 0-n) associated with each user and

Col. 6, lines 45-58);

with processor storing the search terms and unique identifiers in a database, with

each identifier associated with the search terms employed by the associated user *(Col.*

6, lines 1-10, where database is inherent) ;

with a processor

in response to a user visiting a publisher web site, with a processor, determining

the user's unique identifier *(Fig. 3, where "user 0-n" reads on user identifier),* searching

the database to determine an advertising strategy to which the user's unique identifier

was assigned prior to the user's current visit to the publisher web site (*Fig. 3, where*

"table" reads on database and Col. 6, lines 44-58), and serving to the user an

advertisement associated with the advertising strategy *(Col. 12, lines, 17-35, which*

teaches serving advertisements to user via web page (advertising strategy)

Radwin teaches all the above elements, but Radwin does not teach <u>with</u>

<u>processor,</u> generating a plurality of selected advertising strategies, each with an

associated <u>arbitrary</u> Boolean search expression, <u>based on</u> search terms associated with

the associated advertising strategy and assigning identifiers to at least one of the

advertising strategies by comparing the search terms collected for the user to the

Boolean search expression associated with each advertising strategy.

However, Ponte teaches generating a plurality of selected advertising strategies,

each with an associated Boolean search expression *(Col. 27, lines 19-22),* the Boolean

search expression corresponding to search terms associated with the associated

advertising strategy (*Col. 27, lines 26-35*);

assigning identifiers to at least one of the advertising strategies (by comparing

the search terms collected for the user to the Boolean search expression associated

with each advertising strategy *(Col. 27, lines 1-23).* Therefore, it would have been

obvious to the one ordinary skill in the art at the time invention to include Boolean

search expression as taught by Ponte into the system of Radwin in order to provide

user with efficient search system.

Radwin in view of Ponte teaches claim 16. Additionally, Radwin addressed

claim 17 by the rejection of claim 8 as cited above.

Radwin in view of Ponte teaches claim 16. Additionally, Radwin addressed claim 19 by the rejection of clam 11 as cited above.

Radwin in view of Ponte teaches claim 16. Additionally Radwin addressed clam 20 by the rejection of claim 12 as cited above.

Response to Arguments

Applicant's arguments filed 17 November 2008 (8-12) have been fully considered but they are not persuasive.

Applicant argued that Radwin fails to teach or suggest enacting an advertising strategy to which a user has been assigned prior to visiting a publisher web site in response to the user visiting publisher web site in (first paragraph of page 10 of 12). However, the Examiner respectfully disagrees with the applicant because Radwin teaches enacting an advertising strategy to which a user has been assigned prior to visiting a publisher web site in response to the user visiting publisher web site *(Col. 5, lines 28-32, where teaches a search query initiated to user before visiting web site)*, which is cited in claim 10 above.

Applicant argued that Ponte provides no indication that each of a plurality of advertising strategies has an associated Boolean expression. However, the examiner respectfully disagrees with the applicant because Ponte teaches a plurality of advertising strategies has an associated Boolean expression *(Col. 7, lines 34-35, which teaches several Boolean querying terms and Col. 13, lines 35-41, which teaches queries including Boolean search terms (e.g. Col. 1, lines 34-35, search terms targeted banner ads)*.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to SABA DAGNEW whose telephone number is (571)270-

3271. The examiner can normally be reached on 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, James W. Myhre can be reached on 571-272-6722. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. D. /   /Raquel Alvarez/
Examiner, Art Unit 3688   Primary Examiner, Art Unit 3688